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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/733,578

12/12/2003

Tomoko Sugito

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07/27/2006

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EXAMINER

HAND, MELANIE JO

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,578

Applicant(s)

SUGITO, TOMOKO

Examiner

Melanie J. Hand

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/9/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection prompted by applicant's amendment to the claims.

With respect to applicant's argument that Examiner is over-broadly interpreting the tissue paper taught by Lavon as a first sheet, Examiner reminds applicant that claims are given their broadest reasonable interpretation. This interpretation by Examiner is reasonable as the tissue paper is a liquid pervious sheet that covers an upper surface of the absorbent core and wraps around the core, having a lower covering section that covers a lower surface of the core, thereby satisfying those limitations set forth in amended claim 2.

With respect to applicant's argument that the expandable component sheet 200 of Lavon is not disclosed by Lavon to be either liquid –permeable or hydrophilic, Examiner reminds applicant that at no point is the expandable sheet relied upon to reject any of the limitations. Either the tissue paper surrounding the core, or the topsheet taught by Lavon serves as a permeable first sheet, and applicant's arguments regarding these limitations have been addressed previously herein.

With respect to applicant's arguments that Lavon does not teach that pocket void space 311 is below the cleaved zone, Examiner refers applicant to Figs. 3 and 4 taught by Lavon where it is clear that void space 311 is located below the apertures 46 and 47 that collectively form a slit. Examiner reminds applicant that the features upon which applicant relies (i.e., a pocket defined by the tissue that extends below the cleaved zone, not that the tissue paper forms a pocket) are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to applicant's argument regarding new claims 6-10, Examiner acknowledges that Lavon does not teach that topsheet 38 satisfies the limitations of claims 6-10 for a rejection under 35 U.S.C. 102, however Examiner believes that a modification to the topsheet 38 to satisfy the limitations is an obvious modification to the prior art of Lavon, and thus has rejected those claims 6-10 under 35 U.S.C. 103 in view of Lavon alone.

With respect to applicant's arguments regarding independent claim 12, Examiner again acknowledges that Lavon does not anticipate all of the limitations of claim 12 and thus the independent claims, however the modifications to the prior art of Lavon required to render claim 12 unpatentable are obvious modifications and thus claims 12-21 are rejected under 35 U.S.C. 103 in view of Lavon alone or in combination with Wada.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on March 9, 2006 was filed after the mailing date of the Application on December 12, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 3, 5-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lavon et al (U.S. Patent No. 6,458,110).

With respect to **Claim 2**: Lavon teaches a diaper 20 having longitudinal and transverse directions, a front waist region 22, a rear waist region 24 and crotch region 26 that extends between the front waist region and rear waist region. Liquid absorbent core 44 has a body facing upper surface and a lower surface opposite to said upper surface and extends between said front and rear waist regions. Core 44 is encased in a layer of tissue paper (liquid-pervious first sheet) having an upper covering section adapted to cover said upper surface of said core and a lower covering section adapted to cover said lower surface of said core. Core 44 is also disposed between liquid-permeable topsheet 38 and liquid-impermeable backsheet 42 (liquid impervious second sheet), wherein said second sheet lies outside said lower covering section of said first sheet. Core 44 is comprised of two layers, one defined by expandable component 200 having resilient elements 215. Apertures 46 and 47 in said topsheet and core 44 respectively, may be located in any desirable location, which would encompass a location aligned with the penis of a user and define a cleaved zone of core 44 extending in the longitudinal direction and extending through the thickness of core 44. The first sheet of tissue paper extends downward continuously from said upper surface of core 44 along the cleaved zone and then extends outward in the transverse direction. Expandable component 200 defines a z-direction void space 311 that is taught by Lavon as being used for fecal waste storage, but can be used as a pocket to accommodate a user's penis. This void space 311 lined by said first sheet of core 44 (i.e. the upper and lower covering sections cooperate to line the top and bottom of, and define, void space 311) provides a pocket for said penis that has dimensions in the z-direction and extends in the longitudinal direction. Lavon teaches aperture 47 in core 44 and, because of the

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resulting structure of core 44 including aperture 47, the upper covering section of said tissue paper can meet the lower section and cooperate to form a boundary for void space 311.

With respect to **Claims 3,9**: Lavon teaches that absorbent core 44 (including the tissue paper) can be bonded to backsheet 42 in a pattern of adhesive beads constituting a longitudinal or transverse line (Col. 7, lines 18-22), therefore backsheet 42 can be bonded to only a peripheral edge of core 44 and said pocket 311 is free to move below the aperture 46.

With respect to **Claims 5,6**: Apertures 46 and 47 in said topsheet and core 44 respectively, may be located in any desirable location, e.g. in a transversely middle zone of the front waist region aligned with the penis of a user, defining a cleaved zone of core 44 extending in the longitudinal direction and extending through the thickness of core 44.

With respect to **Claim 7**: When oriented in use configuration, the liquid pervious first sheet will define a bottom of void space 311 (pocket).

With respect to **Claim 8**: Lavon teaches aperture 47 in core 44 and, because of the resulting structure of core 44 including aperture 47, the upper covering section of said tissue paper can meet the lower section and cooperate to form a boundary for void space 311 such that all inner walls are defined solely by the liquid pervious first sheet.

With respect to **Claim 11**: As can be seen in Fig. 4 taught by Lavon, void space 311 forms an inverted omega shape where the elements 200 form the rounded portion of the omega and the

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topsheet and core sides (in the apertures 46,47) and the body facing surface of topsheet 38 form the outward legs of the inverted omega shape.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12, 13 and 15-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Lavon et al ('110).

With respect to **Claim 12**: Lavon teaches a diaper 20 having a longitudinal direction and a transverse direction perpendicular to the longitudinal direction, a front waist region 22, a rear waist region 24 and crotch region 26 that extends between the front waist region and rear waist region. Liquid absorbent core 44 extends between said front and rear waist regions and has an upper surface adapted to face a wearer's body in use and a lower surface opposite to said upper surface. Core 44 is encased in a layer of tissue paper (liquid-pervious first sheet) having an upper covering section adapted to cover said upper surface of said core and a lower covering section adapted to cover said lower surface of said core. Core 44 is also disposed between liquid-permeable topsheet 38 (liquid pervious first sheet) that covers at least said upper surface of core 44, and liquid-impermeable backsheet 42 (liquid impervious second sheet), wherein said second sheet lies outside said lower covering section of said first sheet. Apertures 46 and 47 in said topsheet 38 and core 44 respectively form a slit elongated in the longitudinal direction and extending through an entire thickness of said core 44 to divide at least a front portion of said core into two halves. The first sheet 38 is divided into a pair of first sections by aperture 46, each first section extending inwardly in the transverse direction and covering said

upper surface of said core in one of said halves. Aperture 46 also divides first sheet 38 into a pair of second sections, each extending from the respective first section downward in a thickness direction of core 44 through aperture 47. Expandable component 200 defines a z-direction void space 311 that is taught by Lavon as being used for fecal waste storage, but can be used as a pocket to accommodate a user's penis. This void space 311 is lined by said tissue paper wrapping around core 44 (i.e. said second sections define inner side walls of pocket 311) Lavon teaches aperture 47 in core 44 and, because of the resulting structure of core 44 including aperture 47, the upper covering section of said tissue paper can meet the lower section and cooperate to form a boundary for void space 311.

Lavon does not teach that the first sheet 38 defines an inner bottom wall of pocket 311. However, since said first sheet 38 and said tissue paper wrapping around core 44 are both liquid-pervious and Lavon teaches that core 44 may be encased by one or more layers of tissue paper to retain the absorbent material in place. Therefore, it would be obvious to one of ordinary skill in the art to replace a tissue layer with an extended or additional first sheet 38 such that said first sheet 38 has a third section that defines an inner bottom wall of pocket 311 to retain the absorbent material of core 44 in place as taught by Lavon with a reasonable expectation of success.

With respect to **Claim 13**: By modifying the first sheet 38 taught by Lavon such that it forms a third section that defines an inner wall of pocket 311, i.e. it extends around the halves of core 44, such a first sheet would also define a pair of fourth sections each extending inwardly in the transverse direction and covering the lower surface of said core 44 in one of said halves and a fifth section located between said third section and said second sheet that connects said fourth sections wherein said fourth sections define outer side walls of pocket 311 and said fifth section

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defines an outer bottom wall of pocket 311. Lavon teaches that core 44 may be encased by one or more layers of tissue to retain the absorbent material in place, therefore it would be obvious to one of ordinary skill in the art to replace a tissue layer with an extended or additional first sheet 38 such that said first sheet 38 has a third section that defines an inner bottom wall of pocket 311 to retain the absorbent material of core 44 in place as taught by Lavon with a reasonable expectation of success such that first sheet 38 possesses third, fourth and fifth sections as described.

With respect to **Claim 15**: Lavon does not teach a slit that extends continuously over the crotch region and into both front and rear waist regions.

With respect to **Claims 16,17**: Lavon teaches that absorbent core 44 (including the tissue paper) can be bonded to backsheet 42 in a pattern of adhesive beads constituting a longitudinal or transverse line (Col. 7, lines 18-22), therefore backsheet 42 (second sheet) can be bonded to only a peripheral edge of core 44 (longitudinal peripheral edges and fourth sections of first sheet 38) and said pocket 311 is free to move below core 44.

With respect to **Claim 18**: Apertures 46 and 47 define a cleaved zone of core 44 extending in the longitudinal direction and extending through the thickness of core 44. The first sheet of tissue paper extends downward continuously from said upper surface of core 44 along the cleaved zone and then extends outward in the transverse direction. Void space 311 provides a pocket for said penis that has dimensions in the z-direction and extends in the longitudinal direction.

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With respect to **Claim 19**: As can be seen in Fig. 4 taught by Lavon, void space 311 forms an inverted omega shape where the elements 200 form the rounded portion of the omega and the topsheet and core sides (in the apertures 46,47) and the body facing surface of topsheet 38 form the outward legs of the inverted omega shape.

With respect to **Claims 20,21**: With respect to claim 20, by modifying the first sheet 38 taught by Lavon such that it forms a third section that defines an inner wall of pocket 311, such a modified first sheet extends around the halves of core 44. Therefore said second sections of first sheet 38 further extend outwardly in the transverse direction away from said apertures 46,47 to partially cover the lower surface of core 44. With respect to claim 21, also, as a result of this modification, each of said fourth sections of modified first sheet 38 extend inwardly in the transverse direction obliquely from the lower surface of core 44 to an upper surface of second sheet 42. Each of the fourth sections is spaced from the respective second section by an air gap equal to the thickness of the respective half of core 44.

Claims 4,10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavon et al ('110) in view of Wada et al (U.S. Patent No. 6,416,500).

With respect to **Claims 4,10,14**: Lavon teaches that expandable component 200 comprises resilient elements encased in a liquid-impermeable envelope 220. Lavon does not teach that this envelope is adjacent to an upper covering section of said tissue paper, rather that it covers a lower section of tissue paper since core 44 is superposed on resilient elements 215. Wada teaches a urine-retaining bag having a portion of the absorbent core that is cleaved at the point where the portions of the bag are folded together and the penis is inserted into the bag. Wada

teaches that the absorbent core 3 is wrapped in liquid-impermeable film 3c to prevent urine from permeating base sheet 2 and then from leakage, ('500, Col. 8, lines 6-17) therefore it would be obvious to one of ordinary skill in the art to add a liquid-impermeable sheet between topsheet 38 and the tissue paper to prevent rewet as taught by Wada.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie J Hand
Examiner
Art Unit 3761

MJH

TATYANA M. KAEVA
SUPERVISOR EXAMINER

